not represent a logical leap in assumption by anyone skilled in the art to include internal data card reader slots.

It is agreed that Claim 1 of the Application does lay out a general descriptive of an image acquisition apparatus connected to at least one USB equipped computer, comprising: a) image input means for inputting image data into a control circuit within said apparatus; b) transmittal means for sending said image data from said control circuit through the USB system of said computer; c) interface means for said control circuit to receive instructions from, and send data to, control software on said computer. Claim 2 then expanded on the novel aspect of the invention, which are the card reader slots.

Claim 1 is hereby cancelled and Claim 2 amended which removes the issue with respect the generic nature and no longer reads on the reference patents.

With respect to Claim 2, reference patent Kagami discloses an image scanner connected to a computer including various controls for sending image data from a scanner to a computer. The Kagami patent does not disclose any form of internal digital card reader, but rather discloses an external device "(image reader or image scanner IR)", which is not analogous technology to a card reader for the purposes of retrieving digital data therefrom.

With respect to Claim 3, Kagami discloses an external hub which may be used to connect a computer to one or more external devices, none of them being claimed as a digital card reader (Exhibit B). In Kagami, the method disclosed is a "Centronics connector TC mounted on the computer [serving] as an interface relative to a printer PRT (as shown in Fig. 1) and generally has data output lines..." (Col. 5 lines 30-40). This area of the Kagami patent is describing the relationship between a parallel connection of a computer as communicating to an input device such as a scanner. Again, there is no external component to the present invention, and the devices intending to communicate with the computer itself are dissimilar.

Further to Claim 3, which depended from Claim 1 disclosing and claiming the scanner with one or more internal digital card readers, and at least one button on said apparatus wherein said button has a function determined by said control software; b) an interface for said button to direct said control circuit and said control software. With respect to former Claim 3, the Examiner asserts that "Kagami discloses an apparatus comprising simple control means for directing complex operations of said control unit...", "software means", and a "one-button" functionality for directing the control circuit. See Col. 5, lines 10-20 in Kagami for an overall description of this portion of its invention. There is no mention of "one-button" functionality in Kagami as the Examiner asserts. No such button interface relationship on a scanner is disclosed or described therein. In fact, such a feature is intrinsic to the Blair Application (Claim 3(a)) as Visioneer, Inc. has marketed its trademarked "One-Touch" feature since it began manufacturing scanners.

With respect to claim 4, the Examiner asserts that Kagami teaches a scanner comprising all of the mechanical aspects of any typical flatbed scanner. Kagami teaches an external centronics type connector to be interfaced between a computer and devices such as a scanner and a printer, wherein without such connector, only one device would be able to operate from the single computer port. In other words, the Kagami adapter creates a situation wherein a single port may have multiple devices connected. See Col. 3, line 5, wherein the "use of a general interface connector mounted commonly on an image processor such as a general purpose personal computer without use of a dedicated interface". A scanner is not claimed in Kagami as with the present invention, but is used as an example of an external device which may be attached to the Kagami connector.

With respect to claim 5, the Examiner addresses the Kagami patent as disclosing "an image input step for inputting image data into a control circuit within said apparatus; a transmittal step for sending said image data from said control circuit through (interface I/F of Fig. 2) of said computer, etc.". Claim 5 of the rejected application specifically claims image acquisition via a USB port, and the ability to send and receive image data therefrom to a control circuit in concert with control software. None of the Kagami port references are USB ports. However, we agree to amend Claim 5 to include the data in the following dependant claim, which, as with Claims 1 & 2, clarify and specify the invention as containing the internal card readers.

With respect to claim 6, the Examiner asserts Kagami as disclosing a method wherein "said image input step comprises detecting (IR image reader or scanner, as shown in Fig. 1 and 2) the insertion of the appropriate media into at least one of a Compact Flash Memory card reader, Smart Card reader, etc.". Kagami neither discloses nor claims any card reader inputs. As explained above, Kagami discloses a centronics type connector wherein, as an example, both a printer and a scanner could be connected to a single computer port using the Kagami connector. There are no references to card readers in the Kagami patent. Additionally, there are no references to card readers in the Kadota patent.

With respect to claim 7, the Examiner again asserts the "button" feature of Kagami as disclosing a "method further comprising simple control steps for directing complex operations of said control circuit (control unit 40 of Fig. 2) and said control software directly from outside of said apparatus...". In the Blair application, a scanner containing buttons for direction of commands to a control system is distinctly claimed. In the reference Kagami, there are no buttons on their claimed invention (which is a centronics type interface connector), and, further the Blair application teaches buttons for control of the scanner specifically. Kagami makes no such references. The software as disclosed in the Blair application is the software that controls the functionality between the button on the scanner, and its subsequent interface with a connected computer.

With respect to claim 8, the Examiner again quotes the language of the Blair application, as detailed in the claim 6 section above, as somehow corresponding to the Kagami patent in terms of claiming a scanner. Kagami does not claim a scanner.

Kagami merely uses a scanner as one example of a device which may be connected it its inventive centronics type interface connector and a computer.

When applying a §103 rejection, several elements are required. Specific to this rejection, analogy in the arts has not been applied properly. The claimed invention of the Blair application as a whole was not considered properly. First, the Kagami and Kadota patents are not analogous as neither teaches or suggests a scanner with a digital card reader embedded therein. The Examiner references some very generic control circuit language which is germane to any electronic device containing a circuit board. This referencing, however, does not speak to the invention of the Blair application in any rational manner. As in Wang Laboratories, Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQD2d 1767 (Federal Cir. 1993), the art in the reference patents is not within the field of endeavor of the rejected application invention.

The claimed invention as a whole must be considered. The Blair application claims and discloses a scanner wherein one or more digital card readers are a hardware and software integration of said scanner. The communication is accomplished via a USB port on a connected computer. The Kagami reference discloses a centronics type adapter to essentially extend a computer port to more than one external device. The Kadota patent discloses a method wherein a computer may assign identification data to a computer port and similar name data to an external device. Digital card readers are not a part of either application. The suggestion of combining the two patents is completely unsupported as not even approaching analogous art. The Blair invention was, at the time of filing, a completely novel device – a scanner with digital card reader ports on board.

"Patent laws have for their leading purpose the encouragement of useful inventions. Practical utility is their object, and it would be strange if with such object in view the law should consider two things substantially the same which practically and in reference to their utility are substantially different" (Mitchell v. Tilghman, 86 U.S. 287, 1873 WL 16005 U.S.,1873). Here, the present invention and the referenced patents are "substantially different".

In summary, the references used for rejection are not combinable to form a §103 obviousness rejection. They do not address the inventive method or apparatus in the rejected application, nor are they analogous art. An obviousness rejection must consider the invention as a whole, which we again assert has not been done. The rejected application claims a scanner with digital card readers embedded therein, not external hubs connecting to external electronic devices. Finally, claims have been amended to remove ambiguous interpretation and to further avoid the prior art with certainty.

Further, with the claim amendments made herein, the rejection basis is removed with respect to former claims 1 and 5 completely.

As regards the drawings, the matter contained in Figures 6-8 has been cancelled and/or withdrawn from the application claims, and no longer represent the claimed

invention. A new Figure, Figure 1E has been added which does not introduce new matter and is described in the original Specification.

Finally, given the nature of amendments required, a Substitute Specification is also herewith enclosed pursuant to §1.125. Such Substitute Specification contains no new matter.

We respectfully request that the aforementioned Application be allowed with the amendments made herein.

Ron van Os